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REMARKS

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1. In the above-captioned Office Action, the Examiner rejected claims 1-4 and 6-7 under 35 U.S.C. §112, second paragraph. Claims 1-3 and 6-12 were rejected under 35 U.S.C. §103(a) given Schenk (U.S. Patent No. 6,553,664) in view of Farnam (U.S. Patent No. 3,811,689) and further in view of Fucci et al. (U.S. Patent No. 4,819,954). Claims 1-3 and 6-12 were rejected under 35 U.S.C. §103(a) given Belter (U.S. Patent No. 5,168,047) in view of Farnam and in further view of Fucci. Claim 4 was rejected under 35 U.S.C. §103(a) given Schenk in view of Farnam and Fucci, and further in view of Inciong (U.S. Patent No. 6,543,787). Claims 13-20 were rejected under 35 U.S.C. §103(a) given Belter in view of Farnam and Fucci, and further in view of Nenzell (U.S. Patent No. 2,795,444). Claims 13-20 were rejected under 35 U.S.C. §103(a) given Schenk in view of Farnam and Fucci, and further in view of Nenzell. These rejections are traversed and reconsideration is hereby respectfully requested.

2. Claims 1-4 and 6-7 were rejected under 35 U.S.C. §112, second paragraph. The Examiner notes that it is unclear how a gasket can have a fastener, because a gasket assembly can have a fastener but not a gasket.

Applicant respectfully submits that claim 1 describes a gasket, not a gasket assembly. The gasket claimed in claim 1, amended above for clarity, has an *elastomeric ring that has an inner diameter* that is smaller than an *outer diameter* of a fastener that is disposable within the elastomeric ring. Claim 1, and all claims that depend therefrom, are clear and in accordance with 35 U.S.C. §112, second paragraph; the scope of the claimed subject matter can be determined by one having ordinary skill in the art, and is as accurate as the subject matter permits (*Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1585).

3. Claims 1-3 and 6-12 were rejected under 35 U.S.C. §103(a) given Schenk, in view of Farnam, and further in view of Fucci.

The Examiner's rejection seems to rely on the combination of the teachings of Schenk with the rings of Farnam and the dimensioning for rings of Fucci. Before traversing the rejection, the Applicant feels it would be helpful to briefly describe and characterize the Farnam and Fucci references.

Farnam uses bushings, or insert members (24), that "are of a high strength low thermal conductivity material so as to retain the proper size for the bolt hole, as well to support the flange claiming loads of the heat insulating structure" [column 2, lines 47-51; emphasis added]. Farnam does not teach deformation of an elastomeric ring for retention of a fastener; in fact, Farnam teaches the opposite since the insert members (24) are made of a high strength material so as to retain the proper size for the bolt hole.

Fucci teaches use of a *plastic* fastener component that is adapted to be molded into a gasket. The *plastic* fastener of Fucci, or component (10), is "molded as a unitary structure from a suitable plastic such as nylon" [column 2, lines 28-29; emphasis added]. As is well known in the art, *plastic* components or materials are not *elastic* components or materials. An elastic (or elastomeric) component is capable of recovering its size and shape after deformation, contrary to a plastic component that is capable of being deformed continuously and permanently in any direction.

Therefore, the resulting combination of Schenk, Farnam, and Fucci, might yield rings formed around openings in a gasket that are made of a high strength material that retains the proper size for the bolt hole, as taught by Farnam, and even if a fastener having a larger outer diameter than the inner diameter of the ring was inserted, then the ring would deform plastically, as taught by Fucci. Hence, neither Schenk, Farnam, and/or Fucci, alone or in combination, teach an elastomer comprising ... a ring disposed along the inner diameter of the fastener opening, as stated in claims 1 and 8, and also in claim 13.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488

In this case, the first criterion fails in that Farnam teaches that the rings or inserts are made of a high strength material so as to retain the proper size for the bolt hole rather than being deformable so as to retain a fastener therein.

The second criterion fails because there is no reasonable expectation for success in that the resulting combination of Farnam and Fucci will yield a device that will not operate to elastically deform rings surrounding fastener openings, but rather, the resulting combination will have resilient rings that either not deform, or, that deform plastically.

Finally, the third criterion fails in that the combined references fail to teach or suggest all the claim limitations, for example *an elastomer comprising ... a ring disposed along the inner diameter of the fastener opening*, and moreover, the teaching or suggestion to make the claimed combination is absent from the prior art as especially evidenced by the teaching away from the claimed combination by Farnam.

The Examiner has made a 35 U.S.C. §103 rejection, yet has failed to establish a prima facie case for obviousness, and further fails to provide the teachings necessary to fill the gaps in these references in order to yield the invention as claimed. The Examiner has provided mere hindsight as motivation, which is not sufficient to meet the burden of sustaining a 35 U.S.C. §103 rejection. Therefore, the present invention is not obvious in light of any combination of Schenk, Farnam, and/or Fucci.

Thus, claims 1-3 and 6-12 of the present invention are not taught or suggested by Schenk, Farnam, and/or Fucci. Combining these references fails to teach or yield the invention as claimed. The combination of these references fails to teach or suggest all the elements of the claims. Further, one of skill in the art would not be motivated to make such a combination, especially in light of one of the references, Farnam, teaching away from such a combination. Therefore, the present invention is not obvious in light of any combination of Schenk, Farnam, and/or Fucci.

4. Claims 1-3 and 6-12 were rejected under 35 U.S.C. §103(a) given Belter in view of Farnam and in further view of Fucci.

The basis of this rejection is a combination of the gasket of Belter with, as above, the rings of Farnam and the dimensioning for rings of Fucci. As Applicant has shown above, the combination of Farnam and Fucci references fails to teach or yield *an elastomer comprising ... a ring disposed along the inner diameter of the fastener opening* as stated in independent claims 1, 8, and 13. Therefore, any combination of Farnam and/or Fucci with a reference, in this case Belter, to show an elastomeric ring disposed along fastener holes, the ring having an inner diameter that is smaller than an outer diameter of the fastener, fails to teach or yield the invention as claimed.

Therefore, claims 1 and 8, and claims 2, 3, 6-7, and 9-12 that depend therefrom, are allowable over Belter in view of Farnam and further in view of Fucci, and may be passed to allowance.

5. Claim 4 was rejected under 35 U.S.C. §103(a) given Schenk in view of Farnam and Fucci, and further in view of Inciong.

Applicant has shown above that the combination of Schenk in view of Farnam and Fucci fails to teach or suggest all the elements of the claims. Hence, a reliance by the Examiner on the combination of Schenk in view of Farnam and Fucci, with further combination of Inciong, fails to teach *the gasket of claim 1, wherein the elastomeric bead and the elastomeric ring are formed of a continuous rubber material that is formed on the metal substrate*, as stated in claim 4, because the combination fails to teach elements of claim 1, as shown above. Therefore, claim 4 is allowable.

Moreover, Inciong teaches axial compression of elastomeric features in his gasket, and does not teach nor imply having *a fastener that is disposable within the opening and radially compressing the elastomeric ring between the fastener and the opening when the fastener is inserted in the elastomeric ring* as stated in independent claim 1. Inciong does not teach or suggest retaining fasteners with an elastomeric ring of a gasket.

6. Claims 13-20 were rejected under 35 U.S.C. §103(a) given Belter in view of Farnam and Fucci, and further in view of Nenzell.

Applicant has shown above that the combination of Belter in view of Farnam and Fucci fails to teach or suggest all the elements of the independent claims. Hence, a reliance by the Examiner on the combination of Belter in view of Farnam and Fucci, with further combination of Nenzell, fails to teach *wherein the first elastomeric ring has an inner ring diameter that is smaller than the outer shaft diameter*, as stated in claim 13 and as shown above. Therefore, claim 13 is allowable. Moreover, claims 14-20 depend on an independent claim that is shown to be allowable, and for this reason, are themselves allowable.

7. Claims 13-20 were rejected under 35 U.S.C. §103(a) given Schenk in view of Farnam and Fucci, and further in view of Nenzell.

Applicant has shown above that the combination of Schenk in view of Farnam and Fucci fails to teach or suggest all the elements of the independent claims. Hence, a reliance by the Examiner on the combination of Schenk in view of Farnam and Fucci, with further combination of Nenzell, fails to teach *wherein the first elastomeric ring has an inner ring diameter that is smaller than the outer shaft diameter*, as stated in claim 13 and as shown above. Therefore, claim 13 is allowable. Moreover, claims 14-20 depend on an independent claim that is shown to be allowable, and for this reason, are themselves allowable.


8. The above amendment and response is necessary because it places the application in condition for allowance, and was not previously entered because the Examiner first brought the new grounds of rejection in the Final Office Action.

9. The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication may advance the prosecution of the present application. Notice of allowance of claims 1-4 and 6-20 is hereby respectfully requested.

Respectfully submitted,

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